

Application No. 10/808,159

Applicant: Straub

Art Unit: 3671

Examiner: Alexandra Pechhold

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## REMARKS

This Amendment is being submitted in response to the Office Action dated 1 November 2004.

Claims 1 and 4 are amended. Thus, claims 1-21 remain pending in the application.

Applicant acknowledges and appreciates the Examiner's indication that claim 21 is allowed, and that claims 4-20 would be allowable if rewritten in independent format to include the limitations of the base claim. Accordingly, claim 4 is herein amended to stand in independent form, including the limitations of base claims 1 and 3. Claims 5-20 depend from amended claim 4.

The Examiner rejected claims 1 and 3 under 35 U.S.C. 102(b) as being anticipated by Ballesteros (US 5,137,391). Similarly, Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ballesteros (US 5,137,391) as applied to claim 1 above, and further in view of Diana (US 4,769,191). According to the Examiner, "Ballesteros discloses a precast roadway barrier section comprising a mold, seen as mould (5) filled with concrete (Col 6, lines 29-35), made of sheet metal (Col 5, lines 66-68), the mold having a floor and perimeter walls as shown in Fig. 3, a plurality of lengthwise internal walls seen as ribs (25), a plurality of widthwise steel plate bulkheads can be seen as the end walls of the moulds, at least one lifting assembly system embedded therein can be seen as the water passage (15), and an integral reinforcement structure can be seen as rods (28, 29) or the reinforcement ribs (24)." According to the Examiner, this encompasses the structural elements of applicant's claims. However, the Examiner did not give the process limitations of claim 1 patentable weight, despite these being product-by-process claims. Applicant contends that the Examiner has failed to meet her *prima facie* case of anticipation and obviousness because the process limitations of claim 1 were not applied. Clearly, in addition to claiming an article by reciting its structural features, it is also possible to claim the article through a process of making it. In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA

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1969). Applicant specifically intended to do so and can only surmise that he failed because the method limitations appear in the preamble (the Examiner did not specifically state why claims 1 and 3 were viewed solely as product claims, not product by process). Accordingly, claim 1 is herein amended to make the process portions of this claim positive elements of the body of the claim, and the Examiner is now asked to give them patentable weight.

In view of the above, all pending claims 1-21 are believed to avoid all the rejections set forth in the Official Action and thus, the case should be in condition for allowance. A Notice to this effect is respectfully requested, and the Examiner is invited to call the undersigned at 410.385.2383 to discuss any remaining issues.

Respectfully submitted,

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